

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : William M. Shapiro, et al. Art Unit : 2436
Patent No. : 7,930,757 Examiner : David G. Cervetti
Issue Date : April 19, 2011 Conf. No. : 4993
Serial No. : 10/699,124
Filed : October 31, 2003
Title : OFFLINE ACCESS IN A DOCUMENT CONTROL SYSTEM

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Patentees hereby request reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Reconsideration of the final PTA calculation to increase total PTA from 1,207 days to 1,338 days is respectfully requested.

“A Delays” are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. “B Delays” are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. Patentees respectfully submit that the Office did not apply the proper standard for determining the period of “B Delay” under 35 U.S.C. § 154(b)(1)(B).

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

Applicant Delay

There were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of the application as set forth in 37 C.F.R. § 1.704.

“A Delay”

A first PTO action was due on or before December 31, 2004 (the date that is fourteen months after October 31, 2003, the date on which the application was filed). The PTO mailed the first non-final Office Action on June 21, 2007, thereby according a PTO Delay of 902 days. Patentees do not dispute the PTO’s calculation for this “A Delay” from January 1, 2005 (the day

CERTIFICATE OF MAILING BY EFS-WEB FILING

I hereby certify that this paper was filed with the Patent and Trademark Office using the EFS-WEB system on this date: June 1, 2011.

after the date that is fourteen months after the date on which the application was filed), to June 21, 2007. See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

A PTO action was due on or before June 9, 2010 (the date that is four months after February 9, 2010, the date on which a response to Office Action was filed). The PTO mailed a non-final Office Action on July 22, 2010, thereby according a PTO Delay of 43 days. Patentees do not dispute the PTO's calculation for this "A Delay" from June 10, 2010 (the day after the date that is four months after the date on which a response to Office Action was filed), to July 22, 2010. See 37 C.F.R. §§ 1.702(a)(2) and 1.703(a)(2).

In view of the periods of "A Delay" detailed above, the total "A Delay" for this patent should be calculated as 945 days (i.e., the sum of 902 days and 43 days).

"B Delay"

There is no dispute that the Office failed to issue a patent within three years of the filing date of the application and that Patentees are entitled to "B Delay" to compensate for that Office delay. The only issue in contention is the correct length of the "B Delay" period.

The period beginning on November 1, 2006 (the day after the date that is three years after the date on which the application was filed), and ending April 19, 2011 (the date the patent was issued), is 1,631 days in length. The "PTA 36 Months" entry in the PAIR/PALM system indicates that a total of 495 days were awarded for "B Delay" for this patent. Patentees respectfully submit that the PTO's calculation of this "B Delay" is incorrect.

Section 154(b)(1)(B)(i) of Title 35 excludes from the calculation of B Delay "any time consumed by continued examination of the application." In the present matter, a Request for Continued Examination was filed on March 10, 2008. The Director erred in the calculation of patent term adjustment by subtracting from B Delay a period of time that was not "consumed by continued examination of the application." The PTO mailed a Notice of Allowance on December 10, 2010, thereby closing examination of the application on that date. Thus, no continued examination took place during the 131 day period from December 10, 2010 (the mailing date of the Notice of Allowance), until April 19, 2011 (the date the patent was issued). Accordingly, 131 days of B Delay should have been included in addition to the 495 days

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accorded by the Director, for a total B Delay of 626 days. Patentees respectfully submit that the Office's calculation of "B Delay" is incorrect and that the correct PTO Delay for issuance beyond three years from filing is 626 days.

Overlap of "A Delay" and "B Delay"

As detailed above, 945 days of "A Delay" accumulated during the following periods:

January 1, 2005, to June 21, 2007; and

June 10, 2010, to July 22, 2010.

As detailed above, 626 days of "B Delay" accumulated during the following periods:

November 1, 2006, to March 10, 2008; and

December 10, 2010, to April 19, 2011.

As such, the periods of "A Delay" and "B Delay" overlap (i.e., occur on the same calendar day) for a total of 233 days, from November 1, 2006, to June 21, 2007.

Terminal Disclaimer

This patent is not subject to a terminal disclaimer.

Conclusion

In consideration of the events described above, Patentees believe the PTA calculation of 1,207 days is incorrect. As such, Patentees respectfully request reconsideration of the PTA in the following manner:

- 1) Total PTO Delay should be calculated as 1,338 days (i.e., the sum of 945 days of "A Delay" and 626 days of "B Delay" minus 233 days overlapping delay);
- 2) Total Applicant Delay should be calculated as 0 days; and
- 3) Total PTA should be calculated as 1,338 days.

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The \$200 fee required under 37 C.F.R. § 1.18(e) is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other credits or charges to Deposit Account No. 06-1050, referencing Attorney Docket No. 07844-0621001.

Respectfully submitted,

Date: June 1, 2011

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